Rule 1.126

163 ~~165.~~ The method of claim 149 ~~151~~, wherein the step of transmitting comprises the step of automatically forwarding the new travel reservation to a travel agency for post reservation processing. --

REMARKS

In reply to the Office Action dated January 15, 2002, Applicants have cancelled claims 1-35, 64, 67-69, 73-86, 92-98, and 115-118, without prejudice or disclaimer of the subject matter therein, as being drawn to non-elected subject matter, and added new claims 138-165 to protect additional aspects of the elected invention. In the Supplemental Amendment dated January 5, 2001, Applicants added new claims 94-118. In the Amendment dated October 30, 2001, however, Applicants incorrectly added new claims 117-135. Since claims 117 and 118 were already pending at the time this Amendment was filed, Applicants believe that new claims 117-135 were renumbered as claims 119-137, respectively. As a result of this Amendment, claims 99-114 and 119-165 are now pending.

Applicants appreciate Examiner Poinvil's conscientious efforts to expedite the prosecution of this application during the interview of September 10, 2001. Although the Examiner indicated during this interview that the pending claims appeared "to distinguish over the art of record," the Examiner has rejected claims 64, 67-69, 73, 74, 92, 93, 99-112, and 117-135 under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. (U.S. Patent No. 6,023,679) in view of Shoolery et al. (U.S. Patent No. 5,570,283). *See* Office Action pp. 2-6. The Examiner also rejected claims 113-114

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under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. in view of Shoolery et al., and further in view of Kahl et al. (U.S. Patent No. 5,936,625) for the reasons set forth on page 6 of the Office Action.

The prior art, however, fails to render the claimed invention unpatentable. For example, independent claim 99 recites a method including a combination of steps for creating a new travel reservation based on information reflecting frequent trips. This combination includes, among other things, the steps of

> storing in a database a set of frequent trip records, each frequent trip record associated with a traveler and reflecting a travel itinerary;
> receiving selection information reflecting a selected one of the frequent trip records to form a trip request; [and]
> prompting a user to indicate at least one new travel date associated with the trip request regardless of whether the selected frequent trip record has any associated travel dates,

(claim 99, ll. 3-9). Similarly, Applicants have added a new independent method claim 151 that includes, *inter alia*, the steps of:

> storing in a database a set of frequent trip records, each frequent trip record including a travel itinerary associated with a traveler;
> displaying a menu selected from the stored set of frequent trip records;
> prompting a user to select one of the frequent trip records from the displayed menu to form a new travel reservation; [and]
> prompting the user to indicate a new trip travel date for the new travel reservation regardless of whether the selected frequent trip record includes a travel date,

(new claim 151, ll. 3-10). At the very least, Acebo et al., Shoolery et al., and Kahl et al. all fail to disclose or suggest any of these exemplary features recited in claims 99 and 151.

Applicants submit that the Examiner has once again failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated that Acebo et al., Shoolery et al., and Kahl et al., taken either alone or in

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combination, disclose or suggest each and every limitation recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has neglected to show the existence of any reasonable probability of success in modifying Acebo et al. with the teachings of Shoolery et al. and Kahl et al. to somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of Acebo et al., Shoolery et al., and Kahl et al. themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the Acebo et al. device in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than relying on an impermissible hindsight reconstruction of Applicants' own disclosure as is the case here. *See id.*

As discussed during the interview on September 10, 2002, and in the Amendment dated October 30, 2001, Acebo et al. discloses a system for transmitting data from a passenger name record ("PNR") in a computer reservation system ("CRS") to a travel agent's locally operated computer system. Specifically, the Acebo et al. system is directed to a "a method for automatically generating pre-ticketed booked travel reservation information" that includes accessing "traveler identification information, which includes name, address, and billing information . . . from an existing customer profile." Col. 4, ll. 37-46.

Acebo et al., however, does not disclose a method for creating a new travel reservation based on information reflecting frequent trips. For example, the Acebo et al. system does not store a set of frequent trip records, receive selection information reflecting a selected one of the frequent trip records, and prompt a user to supply a new

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travel date associated with a trip request regardless of whether the selected frequent trip record has any associated travel dates, as more particularly recited in independent claims 99 and 151. In fact, Acebo et al. teaches away from the claimed invention by generating a PNR that already includes date information associated with the travel arrangement. The PNR generated by the Acebo et al. system must include date information (i.e., "02 MAY 90") so that a travel agent can customize the process of tracking and analyzing such "pre-ticketed book travel information," as shown in Figs. 3 and 4. Since a date is already present in the PNR of the Acebo et al. system, a skilled artisan would readily recognize that adding a step of prompting a user to indicate a new travel date to the Acebo et al. system, as suggested by the Examiner, would amount to a superfluous and unnecessary exercise. Accordingly, Acebo et al. not only fails to disclose or suggest each and every element recited in independent claims 99 and 151, but also teaches away from the claimed invention.

Turning to the secondary references, Shoolery et al. fails to remedy the deficiencies of Acebo et al. For example, the Examiner relies upon Shoolery et al. solely to allegedly teach the existence of "a corporate travel system in which time and dates are given for a travel request," (Office Action at 4). In this regard, Shoolery et al. states that "if a flight acceptable to the traveler is not displayed, the traveler 34 can re-enter requested flight information requesting different times or dates and thereby redo the process until an acceptable flight is determined." Col. 7, ll. 16-20.

By contrast, independent claims 99 and 151 are directed to methods for creating a new travel reservation based on information reflecting frequent trips. Shoolery et al. is utterly devoid of any suggestion of the specific steps of storing a set of frequent trip

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records, and receiving selection information reflecting a selected one of the frequent trip records, as recited in independent claims 99 and 151. Nor does Shoolery et al. disclose the step of prompting a user to indicate a new travel date associated with a trip request regardless of whether the selected frequent trip record has any associated travel dates, as also recited in independent claims 99 and 151. The Shoolery et al. system only allows a travel agent to re-enter travel time and date information to complete the process of booking a single travel reservation. In reality, a travel agent completes the Shoolery et al. booking process without the use of a set of frequent trip records, as further recited in independent claims 99 and 151. In the Shoolery et al. system, there is further no "selected frequent trip record," let alone the need to indicate a new travel date associated with a new trip request even when such a selected frequent trip record already includes an associated travel date, as called for by independent claims 99 and 151. In addition, Shoolery et al. does not provide any reason for why one skilled in the art would modify the data tracking system of Acebo et al. by adding the extra step of prompting a user to indicate a new travel date, as suggested by the Examiner. Applicants submit that one of ordinary skill in the art would readily recognize that Shoolery et al. simply does not provide any suggestion or motivation for the Examiner's proposed modification of Acebo et al. Consequently, modifying the Acebo et al. system with the teachings of Shoolery et al. would fail to overcome the shortcomings of Acebo et al.

Moreover, even if Acebo et al. could be somehow modified to result in the claimed invention, which it could not, there is no motivation for modifying the Acebo et al. system in the manner suggested by the Examiner. One skilled in the art at the time

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of the invention would not even consider making the Examiner's imagined modification because Acebo et al. explicitly teaches away from the claimed invention, as discussed above. In a similar vein, Shoolery et al. fails to provide any reason for one skilled in the art to add the superfluous and unnecessary steps suggested by the Examiner to the Acebo et al. system. Indeed, the Examiner's unsupported modification would unnecessarily change the principles of operation of both the Acebo et al. and Shoolery et al. systems. The Manual of Patent Examining Procedure ("MPEP") specifically states that if the "proposed modification would . . . change a principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 at 112-13 (7th ed. 1998). There is further no motivation generally known within the art to modify the Acebo et al. and Shoolery et al. systems to operate in the manner imagined by the Examiner. In this regard, the Examiner has not even asserted Official Notice to overcome the inadequacies of the Acebo et al. and Shoolery et al. systems. Therefore, it is only through hindsight afforded by Applicants' own disclosure that the Examiner can even assert that Acebo et al. and Shoolery et al. somehow suggest each and every element of the claimed invention. Such hindsight determinations are impermissible under 35 U.S.C. § 103.

In addition, Kahl et al. also fails to overcome the shortcomings of Acebo et al. and Shoolery et al. For example, the Examiner relies upon Kahl et al. solely to allegedly teach the existence of a calendar having icons, (*see* Office Action at 6). As a result, each of the secondary references fails to remedy the deficiencies of Acebo et al.

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For at least these reasons, Acebo et al., Shoolery et al., and Kahl et al. all fail to disclose or render obvious each and every element recited in independent claims 99 and 151. Additionally, claims 100-114, 119-150, and 152-165, which are each dependent upon one of the independent claims, respectively, recite additional limitations that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims are allowable for at least the same reasons discussed above with respect to independent claims 99 and 151.

Should it be necessary to resolve any additional concerns to expedite the issuance of a Notice of Allowance, the Examiner is invited contact Applicants' representative at (202) 408-6052.

Please grant any extension of time to the extent required to enter this response and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

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Dated: April 15, 2002

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